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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/505,282	08/20/2004	Mikio Ikenishi	330-281	5541
23117 7590 01/10/2007 NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON, VA 22203			EXAMINER	
			FALASCO, LOUIS V	
			ART UNIT	PAPER NUMBER
			1773	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		01/10/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)
	10/505,282	IKENISHI ET AL.
	Examiner	Art Unit
	Louis Falasco	1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 31 October 2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-11 is/are pending in the application.
 - 4a) Of the above claim(s) 4-11 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-3 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date <u>10/26/04</u> .	6) <input type="checkbox"/> Other: _____ .

DETAILED ACTION

Papers Received

1. The Response to Restriction requirement filed 10/31/06.
2. The Information Disclosure Statement filed 10/26/04.

Claims

3. The claims are: 1 to 11.

Election/Restriction of Invention

4. Applicant's election of Group I, species A, corresponding to claims 1 to 3, in the Response to Restriction filed on 10/26/04 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
5. The claims 4 to 11 have been withdrawn.
6. The claims under consideration are 1 to 3.

The requirement has been made FINAL.

Claim Rejections - 35 U.S.C. §102 and 35 U.S.C. §103

Statutory Basis

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Rejections

7. Claims 1 to 3 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over **Nakashima et al** (US 6387510).

Nakashima et al teaches the requirements of these claims except failing to addressing the (characteristic) etching rate for the glass.

Nakashima et al teaches a glass substrate for an information recording medium, having a *glass transition temperature (Tg)* range 600°C or higher (**Nakashima et al** col. 3 lns 12, 13 and Examples summarized at Tables 1-5 cols. 8 - 11).

Though **Nakashima et al** does not make reference to an *etch rate*, this is merely a characteristic of the glass inherent in its components dissolution reactions (e.g., SiO_2 , etc.). Since **Nakashima et al** teaches the same composition as that disclosed so it would be expected to fall into the same *etch rate* range. The *etch rate* is merely an inherent property of the glass composition the same composition would be expected to have the same properties, see MPEP 2112.01 II. '[T]he discovery of the property of a prior art composition . . . does not render the old composition patentably new to the discoverer.'

Atlas Powder Co. v. Ireco Inc., 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999); In re Best, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977); In re Crish, 393 F.3d 1253, 1258, 73 USPQ2d 1364, 1368 (Fed. Cir. 2004); etc.

Alternate to anticipation: it would have been at least obvious to one having ordinary skill in the art at the time the invention was made to adopt an etch rate within 0.1 $\mu m/minute$ or less with a *hydrosilicofluoric acid* aqueous solution maintained 45°C and a *hydrosilicofluoric acid* concentration at the instant 1.72% by weight within the **Nakashima et al** glass composition by routine optimize intended production conditions as conventional efficiency trade offs between production conditions. When a product

has been shown to have the same composition it is applicants burden to demonstrate they are different products.

As regard claim 2 and 3: the Nakashima et al glass substrate has a SiO_2 , Al_2O_3 , CaO and K_2O ('contains . . . as essential components' is considered open MPEP 2111.03) and a composition comprising, in mol %: 45 to 70% of SiO_2 , 1 to 15% of Al_2O_3 , with the total content of SiO_2 and Al_2O_3 between 57 to 85%; 2 to 25% of CaO , 0 to 15% of BaO , 0 to 15% of MgO , 0 to 15% of SrO , 0 to 10% of ZnO , with the total content of MgO , CaO , SrO , BaO and ZnO between 2 to 30%; more than 0% but not more than 15% of K_2O , 0 to 8% of Li_2O , 0 to 8% of Na_2O , the total content of K_2O , Li_2O and Na_2O between 2 to 15%; 0 to 12% of ZrO_2 and 0 to 10% of TiO_2 , the total content of above components being at least 95% (see Nakashima et al col. 2 lns 42 – 57, col. 3 lns 3 to col. 4 ln 14, noting the optimization of SiO_2 and Al_2O_3 pointed out at col. 4 lns 15 – 30 and Tables 1 through 5 compositions at columns 8 to 11).

8. Alternatively: claims 1 to 3 are rejected under 35 U.S.C. §103(a) as being unpatentable over Nakashima et al (US 6387510) taken with Miyamoto (US 6395634).

Nakashima et al teaches the requirements of these claims except failing to address a characteristic etch rate for the glass - specifically an etch rate of $0.1 \mu m/minute or less$ with regard to a hydrosilicofluoric acid aqueous solution maintained at $45^\circ C$. and a 1.72% by weight *hydrosilicofluoric acid concentration*.

Nakashima et al teaches a glass substrate for an information recording medium, having a *glass transition temperature (Tg)* is $600^\circ C$ or higher (Nakashima et al col. 3 lns 12,13).

Though Nakashima et al does not make reference to a rate of the etch for the glass. Miyamoto teaches the worker of ordinary skill optimizing the glass substrate formulations within an etch rate within $0.1 \mu\text{m}/\text{minute}$ or less (Miyamoto col. 7 lns 4-15) with a hydrosilicofluoric acid aqueous solution maintained within 45°C and a *hydrosilicofluoric* acid concentration in the middle of the instant 1.72% by weight (Miyamoto col. 7 lns 28).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to adopt an etch rate within $0.1 \mu\text{m}/\text{minute}$ or less with a *hydrosilicofluoric* acid aqueous solution maintained 45°C and concentration at the instant 1.72% within the Nakashima et al glass composition would have been obvious to one having ordinary skill in the art at the time the invention was made to optimize the glass of Nakashima et al to an etch rate within $0.1 \mu\text{m}/\text{minute}$ or less with a *hydrosilicofluoric* acid aqueous solution maintained 45°C and a concentration of 1.72% as shown by Miyamoto for the purpose of routinely balancing processing conditions such as time and temperature, controlling the substrate surface characteristics. One skilled in the art would have been motivated to adopt the Miyamoto with the expectation of increasing the surface of the substrate for magnetic recording media (Miyamoto col. 6 lns 62-64, col. 7 lns 16-17, col. 8 lns 21-24).

As regards claims 2 and 3: the Nakashima et al glass substrate has SiO_2 , Al_2O_3 , CaO and K_2O (instant claim 2) glass composition comprising, in mol %: 45 to

70% of SiO_2 , 1 to 15% of Al_2O_3 , with the total content of SiO_2 and Al_2O_3 between 57 to 85%; 2 to 25% of CaO , 0 to 15% of BaO , 0 to 15% of MgO , 0 to 15% of SrO , 0 to 10% of ZnO , with the total content of MgO , CaO , SrO , BaO and ZnO between 2 to 30%; more than 0% and not more than 15% of K_2O , 0 to 8% of Li_2O , 0 to 8% of Na_2O , the total content of K_2O , Li_2O and Na_2O between 2 to 15%; 0 to 12% of ZrO_2 and 0 to 10% of TiO_2 , the total content of above components being at least 95% (Nakashima et al col. 2 lns 42 – 57, col. 3 lns 3 to col. 4 ln 14, noting the optimization of SiO_2 and Al_2O_3 pointed out at col. 4 lns 15 – 30 and Examples summarized at Tables 1 though 5 at cols. 8 - 11).

Double Patenting

Judicial basis

This is a provisional obvious-type double patenting rejection because the conflicting claims have not in fact been patented.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double

patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1 to 3 are rejected under the judicially created doctrine of obviousness-

type double patenting as being unpatentable over claims 1 to 4 of copending

Application No. SN 10/532863 (corresponding to US 2006/0216552) alone or in view of with Miyamoto (US 6395634).

Application No. 10/532863 claims what has been instantly claimed except failing to address a characteristic etching rate - specifically an etch rate of $0.1 \mu\text{m}/\text{minute}$ or less with regard to a *hydrosilicofluoric acid* aqueous solution maintained at 45°C . and a 1.72% by weight *hydrosilicofluoric acid concentration*.

Application No. 10/532863 claims (re: claims 1 to 3) glass substrate for an information recording medium, having a *glass transition temperature (Tg)* of 600°C or higher. The glass substrate has SiO_2 , Al_2O_3 , CaO and K_2O (as instant claim 2) glass composition comprising, in mol %: 45 to 70% of SiO_2 , 1 to 15% of Al_2O_3 , with the total content of SiO_2 and Al_2O_3 between 57 to 85%; 2 to 25% of CaO , 0 to 15% of BaO , 0 to 15% of MgO , 0 to 15% of SrO , 0 to 10% of ZnO , with the total content of MgO , CaO , SrO , BaO and ZnO between 2 to 30%; more than 0% but not more than 15% of K_2O , 0 to 8% of Li_2O , 0 to 8% of Na_2O , the total content of K_2O , Li_2O and Na_2O between 2 to

15%; 0 to 12% of ZrO_2 and 0 to 10% of TiO_2 , the total content of above components being at least 95% (instant claim 3 and claim 1 of application 10/532863). Though application SN 10/532863 does not claim reference to an *etch rate*, The instant etch rate would have been obvious from the glass substrate composition SN 10/532863 claims as a mere matter of optimization of the composition since Miyamoto teaches the worker of ordinary skill to optimize to the instantly claimed etch rate within $0.1 \mu m/minute$ or less (Miyamoto col. 7 lns 4-15) with a *hydrosilicofluoric acid* aqueous solution at $45^\circ C$ and a *hydrosilicofluoric acid* concentration in the middle of the instant 1.72% by weight (Miyamoto col. 7 lns 28).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to optimize the composition claimed in application 10/532863 to an *etch rate* the within $0.1 \mu m/minute$ or less with a *hydrosilicofluoric acid* aqueous solution maintained at $45^\circ C$ and a *hydrosilicofluoric acid* concentration at 1.72 as taught by Miyamoto for the purpose of routinely balancing processing conditions such as time and temperature, controlling the substrate surface characteristics. One skilled in the art would have been motivated to adopt the Miyamoto with the expectation of increasing the surface of the substrate for magnetic recording media (Miyamoto col. 6 lns 62-64, col. 7 lns 16-17, col. 8 lns 21-24) and with the expectation of increasing the surface of the substrate for magnetic recording media (Miyamoto col. 6 lns 62-64, col. 7 lns 16-17, col. 8 lns 21-24).

Other References

Marshall (US 5499731) and **Wilson et al** (US 5895582) are cited as being of interest teaching that etch rates, such as instantly claimed, are routinely optimized for balancing properties as tensile and rupture strengths, oxidation resistance and the ability of the sheet material to be formed or worked." both teach an etch rate as a corresponding to a composition optimally balancing production temperature conditions while controlling the smoothness of the substrate of optimization

Marshall and **Wilson et al** both teach glass comprised of SiO_2 and Al_2O_3 between 57 to 85%, MgO , CaO , Na_2O , and K_2O and point out that the etch rate is an inherent property of the glass and the etch rate is routinely optimized so as to be compatible with substrate processing conditions. Both show this in accordance with well known operating conditions including temperature - the etch rate is known to vary linearly with temperature (see **Marshall** at col. 3 lns 5-8, col. 8 lns 25-28, col. 9 lns 16-21 and **Wilson et al** col. 2 lns 59-62, col. 7 lns 2-12).

Zou (US 6599606) is cited as being of interest cumulatively teaching a glass substrate for an information recording medium, having a *glass transition temperature (T_g) = 600°C* or higher (**Zou** col. 8 lns 5, 15, 16; and *T_g* in example compositions shown in Table 2 col. 13 and Table 3 col. 15).

Conclusion

10. The claims are 1 to 11.
 - Restriction has been required.
11. The invention elected corresponds to claims 1 to 3.
 - Claims 1 to 3 have been rejected.
 - No claim has been allowed.
12. Information Disclosure Statement has been received and considered.

INQUIRIES

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Louis Falasco, PhD whose telephone number is (571)272-1507. The examiner can normally be reached on M-F 10:30 - 7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol D. Chaney, PhD can be reached at (571)272-1284. The fax phone number for the organization where this application or proceeding is assigned is (571)273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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12/06


CAROL CHANEY
SUPERVISORY PATENT EXAMINER